

Remarks:

Claims 1-29 are pending in the current application and have been rejected under 35 U.S.C. 103(a). In response, Applicants have amended claims 1-5, 10, 15-22, and 24-26 and added new claims 31-37. Claims 6-9, 13, and 27-29 have been canceled. No new matter has been added. Support for the amended language is provided in the specification and the drawings. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§103 Rejection(s):

Claims 1-4, 6, 8, 11-15, 18, 20-24, 27, and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,983,312 to O'Neil (hereafter *O'Neil*) in view of U.S. Patent Application No. 2002/0046131 to Boone et al (hereafter *Boone*). Claims 5, 9, 16, 25, and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over *O'Neil* in view of *Boone* and further in view of U.S. Patent No. 6,147,986 to Orsic (hereafter *Orsic*). Claims 7, 17, and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over *O'Neil* in view of *Boone* and further in view U.S. Patent Application No. 2002/0075844 to Hagen (hereafter *Hagen*). These rejections are respectfully traversed.

MPEP §2143 provides:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

O'Neil fails to teach or suggest all the elements recited in claim 15, which is amended to more distinctly recite the elements of the invention. *O'Neil* discloses a method of scheduling to record multimedia content on a first device via a second wireless communication device. The wireless communication device includes a short range wireless transceiver that is able to communicate with a short range wireless transceiver co-located in the environment of the first

device in order to schedule the recording of content on the first device. The wireless communication device also includes a long range wireless transceiver that is able to retrieve a list of multimedia hyperlinks from the Internet. See *O'Neil*, col. 1, lines 51-61; col. 6, lines 4-25.

In particular, *O'Neil* fails to disclose “generating a cellular signal to obtain the cellular network attribute from the cellular network over a first connection in response to one of the following: receiving a first short-range radio message requesting the cellular network attribute from the first terminal over a second connection, establishing the second connection with the first terminal, expiration of a threshold time period since connecting to the cellular network, and comparing a current Internet Protocol (“IP”) address and access point name (“APN”) to a previous IP address and APN, respectively; receiving the cellular network attribute from the cellular network over the first connection; terminating the first connection in response to completing receiving the cellular network attribute from the cellular network; generating, for the first terminal, a second short-range radio message including the cellular network attribute; and terminating the second connection in response to completing generating the second short-range radio message,” as recited in claim 15.

The Examiner admits that *O'Neil* fails to disclose obtaining the cellular network attribute from the cellular network. See Office Action, page 3. The generating and receiving of the cellular signals and short-range radio messages recited in claim 15 are directed to obtaining the cellular network attribute from the cellular network. On the other hand, the generating and receiving of cellular signals and short-range radio messages disclosed in *O'Neil* are directed to retrieving a list of multimedia hyperlinks from the Internet. See *O'Neil*, col. 1, lines 51-61; col. 6, lines 4-25. The content and purpose of the cellular signals and short-range radio messages recited in claim 15 and disclosed in *O'Neil* are completely different.

Additionally, the claimed invention teaches selectively connecting to the cellular network and the first terminal in order to obtain the cellular network attribute. As recited in claim 15, communication with the cellular network is initiated in response to “receiving a first short-range radio message requesting the cellular network attribute from the first terminal over a second connection, establishing the second connection with the first terminal, expiration of a threshold

time period since connecting to the cellular network, and comparing a current Internet Protocol (IP) address and access point name (APN) to a previous IP address and APN, respectively.” The connection to the cellular network is terminated after receiving the cellular network attribute from the cellular network, and the connection to the first terminal is terminated after the cellular network attribute is sent to the first terminal.

Boone also fails to teach or suggest all the elements recited in claim 15. *Boone* discloses a method to “facilitate network-based commerce.” When a user enters a uniform resource locator (“URL”) for a site operated by a network-based commerce facility into a browser, the corresponding Internet Protocol (“IP”) address is looked up in the top-level server for the region. See *Boone*, paragraphs [0035], [0047]. The server retrieves a category list for the site that identifies categories of offerings available via the site and displays the category list to the user. Both the site and the category list are region-specific, providing geographically customized information and interfaces to the user. See *Boone*, paragraph [0004], [0029].

In particular, *Boone* fails to disclose “generating a cellular signal to obtain the cellular network attribute from the cellular network over a first connection in response to one of the following: receiving a first short-range radio message requesting the cellular network attribute from the first terminal over a second connection, establishing the second connection with the first terminal, expiration of a threshold time period since connecting to the cellular network, and comparing a current Internet Protocol (“IP”) address and access point name (“APN”) to a previous IP address and APN, respectively; receiving the cellular network attribute from the cellular network over the first connection; terminating the first connection in response to completing receiving the cellular network attribute from the cellular network; generating, for the first terminal, a second short-range radio message including the cellular network attribute; and terminating the second connection in response to completing generating the second short-range radio message,” as recited in claim 15.

The Examiner contends that *Boone* discloses obtaining a cellular network attribute in the same field of endeavor because *Boone* discloses obtaining a domain name service (DNS) or IP address. See Office Action, page 3. It is respectfully submitted that the invention in *Boone* and

the claimed invention as recited in claim 15 are not in the same field of endeavor. The invention in *Boone* relates generally to the field of Internet-based commerce. See *Boone*, paragraph [0002]. The claimed invention, on the other hand, relates generally to networks. See Specification, page 1, line 31. *Boone* discloses obtaining a DNS or IP address merely in conjunction with entering a commerce site through an Internet browser. In other words, *Boone* does not disclose a terminal in a short distance wireless network obtaining a cellular network attribute through a device connected to a cellular network.

Orsic also fails to teach or suggest all the elements recited in claim 15. *Orsic* discloses a method of defining an address for a mobile terminal host linked to a wired communications network. The method includes assigning an address to the mobile terminal host, wherein the address corresponds in part to a first network base station to which the mobile terminal host is connected. When the terminal host roams and becomes connected to a second network base station, the terminal host obtains a current IP address and at least one stationary terminal host in the network is informed of the current address assigned to the mobile terminal host. See *Orsic*, Abstract; col. 4, lines 46-49; col. 5, lines 38-50.

In particular, *Orsic* fails to disclose “generating a cellular signal to obtain the cellular network attribute from the cellular network over a first connection in response to one of the following: receiving a first short-range radio message requesting the cellular network attribute from the first terminal over a second connection, establishing the second connection with the first terminal, expiration of a threshold time period since connecting to the cellular network, and...; terminating the first connection in response to completing receiving the cellular network attribute from the cellular network; generating, for the first terminal, a second short-range radio message including the cellular network attribute; and terminating the second connection in response to completing generating the second short-range radio message,” as recited in claim 15.

Hagen also fails to teach or suggest all the elements recited in claim 15. *Hagen* discloses a system and method that enables terminals to access public networks, such as the Internet, at broadband data rates, via fixed, wireline, or wireless network connections, and at geographically dispersed network access points using the existing public network connections of private or

proprietary networks. *Hagen* also discloses measuring an amount of time since a mobile cellular communication device established a cellular data service session and comparing the measured amount of time to a threshold value. See Office Action, page 16; *Hagen*, paragraph [0193].

In particular, *Hagen* fails to disclose “generating a cellular signal to obtain the cellular network attribute from the cellular network over a first connection in response to one of the following: receiving a first short-range radio message requesting the cellular network attribute from the first terminal over a second connection, establishing the second connection with the first terminal, expiration of a threshold time period since connecting to the cellular network, and comparing a current Internet Protocol (“IP”) address and access point name (“APN”) to a previous IP address and APN, respectively; receiving the cellular network attribute from the cellular network over the first connection; terminating the first connection in response to completing receiving the cellular network attribute from the cellular network; generating, for the first terminal, a second short-range radio message including the cellular network attribute; and terminating the second connection in response to completing generating the second short-range radio message,” as recited in claim 15.

For the above reasons, *Boone*, *Orsic*, and *Hagen*, either alone or in combination, fail to cure the deficiencies of *O’Neil*, as they also fail to disclose “generating a cellular signal to obtain the cellular network attribute from the cellular network over a first connection in response to one of the following: receiving a first short-range radio message requesting the cellular network attribute from the first terminal over a second connection, establishing the second connection with the first terminal, expiration of a threshold time period since connecting to the cellular network, and...; terminating the first connection in response to completing receiving the cellular network attribute from the cellular network; generating, for the first terminal, a second short-range radio message including the cellular network attribute; and terminating the second connection in response to completing generating the second short-range radio message,” as recited in claim 15.

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have

been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (emphasis added).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicants' disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. *In re Geiger*, 2 USPQ2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicants' claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicants invite the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

hindsight and conjecture, it is respectfully requested that the 103 grounds of rejection be withdrawn.

Accordingly, since none of the cited references, either alone or in combination, teach or suggest the invention as recited in claim 15, it is respectfully submitted that claim 15 is in condition for allowance. Claims 16-23 depend on claim 15 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Amended claim 1 and claim 24 substantially incorporate the elements of claim 15; therefore claims 2-5, 10-12, and 14 and claims 25-26 and 31-37, which depend from claims 1 and 24, respectively, should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (310) 789-2100 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

/F. Jason Far-hadian/

Date: June 6, 2008

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